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EXAMINER

LOUIS JACQUES, J

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UNITED STATES DEPARTMENT OF COMMERCE
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 30

Application Number: 08/852,119

Filing Date: May 06, 1997

Appellant(s): JONES, MARTIN

JON E. HOLLAND
For Appellant

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GROUP 3600

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed September 27, 1999.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

Art Unit: 3661

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 1-21, 23-49 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,444,444	ROSS	09-95
5,648,770	ROSS	07-97

Art Unit: 3661

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 U.S.C. § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

2. Claims 1-21, 23-35, 37-41, 43-47 and 49 are rejected under 35 U.S.C. 102(e) as being anticipated by Ross [5,444,444].

Ross '444 discloses an apparatus and method of notifying a recipient of an unscheduled delivery. The vehicle is equipped with a satellite receiver, a controller and a communicator. The position of the vehicle is determined based on positioning data or signals. The controller compares the current vehicle location or position to the location in the mapped are. The communicator then communicates with the user to notify user. As shown in figure 1, there are provided controllers (10 and 21), a video screens or computer displays (14 and 26). As described in column 2, a time interval (timing information) and distance (distance information) are computed. Ross discloses the time period, and the predetermined distance as well as the telephone interface or communication. Also, a message or notification is forwarded to user via a telephone associated therewith. See column 6. As explained, more specifically in the claim section, Ross discloses a voice

Art Unit: 3661

generator for generating or producing an audible message to notify the party. See columns 3-6 and the claim section

3. Claims 1-21, 23-35, 37-41, 43-47 and 49 are rejected under 35 U.S.C. 102(e) as being anticipated by Ross [5,648,770].

Ross '770 discloses an apparatus and method of notifying a party of a pending delivery or pickup. A mobile receiver or carrier is equipped with a satellite receiver, a controller and a communicator. The position of the vehicle is determined based on positioning data or signals. The controller compares the current vehicle location or position to the location in the mapped area. The communicator then communicates with the user to notify user. As shown in figure 1, there are provided controllers (10 and 21), a video screens or computer displays (14 and 26). As disclosed in column 2, an analyzer evaluates the positioning signals to determine the position of the carrier, the position of the carrier is compared with a predetermined location, a time interval is computed, and when the time interval is less than a predetermined time interval, a signal is communication to provide reasonable advance notice. See column 2. Also, a message or notification is forwarded to user via a telephone associated therewith. See columns 5 and 6. As explained, more specifically in the claim section, Ross discloses a voice generator for generating or producing an audible message to notify the party. Ross discloses the time period, and the predetermined distance as well as the telephone interface or communication. See columns 3-5 and the claim section.

Art Unit: 3661

Claim Rejections - 35 U.S.C. § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 36, 42 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ross [5,648,770], in the alternative Ross [5,444,444].

While neither Ross '770 nor Ross '444 specifically teaches the communication over the Internet, it would have been obvious to one skilled in the art at the time of the invention to be motivated to incorporate the use of the Internet into the Ross apparatuses and methods because such modification will enable to communicate with a various numbers of parties all over the world.

(11) Response to Argument

The present application was on filed on May 6, 1997 and was assigned a serial number 08/852,119. In an paper filed before the Office, the present application was assigned to Global Research System, Inc. However, in filing the Appeal Brief, appellant states that the present application is assigned to Global Research Systems, Inc. and Buscall Properties, L.L.C.

The present application names only one inventor, Martin Kelly Jones, and has an effective US filing date of May 6, 1997.

Art Unit: 3661

During the prosecution of the present application, the claims were rejected over US Patents 5,444,444 and 5,564,770, both of which are issued to John Ross. Both patents name only inventor, John Ross, and are assigned to Worldwide Notification Systems, Inc.

The US Patent 5,444,444 has an effective US filing of May 14, 1993, and US Patent 5,648,770 has the same effective US filing date. The US application 08/417,947, which matured as US Patent 5,648,770 on July 15, 1997, is a continuation of US patent application 08/307,032, which matured as US patent 5,444,44, and which in turn is a continuation of US application 08/062,405, filed on May 14, 1993 which is now abandoned.

In arguing the rejections, appellant contended that “[T]he fact that an application named a different inventive entity than a patent does not constitute necessarily make that patent prior art.”, citing Applied Materials Inc. V. Gemini Research Corp¹.

The examiner agrees. *However, if the patent has an earlier US effective filing date than the application, such patent is considered to be prior art.* In the present case, the present application as filing date of May 6, 1997, while the prior art references have an effective US filing date of may 14, 1993.

Appellant continued by stating that, citing In re DeBaun², “[A]n applicant’s own work, even though publicly disclosed prior to his application, may not be used against him as a reference, absent the existence of a time bar to his application.”

¹ 15 U.S.P.Q.2d 1816, 1818 (Fed. Cir. 1988).

Art Unit: 3661

The examiner agrees. *However, this only applies to the same applicant for the patent and the application. By same applicant, it's meant the same inventive entity.* In the present case, the present application names only Martin Kelly Jones, while the applied patents name only John Ross.

Appellant further asserted that “[a]n applicant may overcome a rejection based on a patent ‘by showing that the patent disclosure is a description of applicant’s own previous ...’”, citing M.P.E.P § 2136.05 and In re Mathews³.

The examiner agrees. However, this can only happen in the case where i) applicant is one of a group of inventors of the patent or ii) the application and the patent are assigned to the same assignee. In the present case, the present application names only one inventor, Martin Kelly Jones and the US patents name only one inventor, John Ross. In order for condition i) above to apply, the patents in question must have Martin Kelly Jones as one of its inventors. In addition, the present application is assigned to Global Research Systems, Inc. while the patents are assigned to Worldwide notification Systems, Inc. In the case of the present situation, the patents applied against the claims of the present application are Ross [5,444,444] and Ross [5,648,770], both of which named only one inventor John Ross and are assigned to Worldwide Notifications Systems, Inc. Therefore, neither condition i) nor condition ii) applies.

Appellant attempted to show the similarities between the present application and the case in In re Mathews. However, one major difference between the present applicant

² 214 U.S.P.Q. 933, 935 (C.C.P.A. 1982).

Art Unit: 3661

and the In re Mathews' case is that Dewey and Mathews were co-workers. In the present case, there is no showing (other than applicant's statement) that applicant and Ross were co-workers. In fact, let it be known that the US patents to Ross, which named only one inventor, Mr. John Ross, are assigned to Worldwide Notification Systems, Inc. and the present application, which names only one inventor, Mr. Martin Kelly Jones, is assigned to Global Research systems, Inc.

The mere fact that the declaration filed on February 8, 1999 includes a statement, by applicant, that applicant is a "co-inventor" of the patents to Ross and that applicant invented the subject matter disclosed in the patents to Ross, is not a basis to remove the Ross patents as prior art and withdrawn the rejections.

Based on the limited information presented herein, the examiner is not able to make a decision as to withdrawn the rejections. Applicant would need a disclaimer from Mr. Ross and/or the assignee of the Ross patents affirming that applicant's statement is true or any other evidence showing such.

Now let's turn to the application of these references as prior art under 35 U.S.C 102 (b) and (e).

35 U.S.C. 102(e) states that:

A person shall be entitled to a patent unless --

the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the

³ 161 U.S.P.Q. 276 (C.C.P.A. 1969).

Art Unit: 3661

requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by applicant for patent, or

The MPEP states that a rejection can be overcome by: (3) Filing an affidavit or declaration under 37 CFR 1.132 showing that the reference invention is not by "another." See MPEP § 715.01(a), § 715.01(c), and § 716.10.

That is, in order for the affidavit to be acceptable, it must meet the requirements of MPEP § 715.01(a), § 715.01(c), and § 716.10.

MPEP § 715.01(a) Reference Is a Joint Patent to Applicant and Another [R - 1]

When subject matter, disclosed but not claimed in a patent **issued jointly to S and another**, is claimed in a later application filed by S, the joint patent is a valid reference unless overcome by affidavit or declaration under 37 CFR 1.131 or an unequivocal declaration under 37 CFR 1.132 by S that he/she conceived or invented the subject matter disclosed in the patent and relied on in the rejection. In re DeBaun , 214 USPQ 933 (CCPA 1982). See MPEP § 716.10 for a discussion of the use of 37 CFR 1.132 affidavits or declarations to overcome rejections by establishing that the subject matter relied on in the patent was the invention of the applicant. Disclaimer by the other patentee should not be required but, if submitted, may be accepted by the examiner.

Although affidavits or declarations submitted for the purpose of establishing that the reference discloses applicant's invention are properly filed under 37 CFR 1.132, rather than 37 CFR 1.131, such affidavits submitted improperly under 37 CFR 1.131 will be considered as though they were filed under 37 CFR 1.132 to traverse a ground of rejection. In re Facius , 408 F.2d 1396, 161 USPQ 294 (CCPA 1969).

Art Unit: 3661

That is NOT the case here. The present application and the patent has no common inventor, i.e., the patent was NOT issued jointly by John Ross and Martin Kelly Jones.

MPEP § 715.01© Reference Is Publication of Applicant's Own Invention [R - 2]

Unless it is a statutory bar, a rejection based on a publication may be overcome by a showing that it was published either by applicant himself/herself or on his/her behalf. Since such a showing is not made to show a date of invention by applicant prior to the date of the reference under 37 CFR 1.131, the limitation in 35 U.S.C. 104 and in 37 CFR 1.131(a)(1) that only acts which occurred in this country or in a NAFTA or WTO member country may be relied on to establish a date of invention is not applicable. Ex parte Lemieux , 115 USPQ 148, 1957 C.D. 47, 725 O.G. 4 (Bd. App. 1957); Ex parte Powell **, 1938 C.D. 15, 489 O.G. 231 (Bd. App. 1938). See MPEP § 716.10 regarding 37 CFR 1.132 affidavits submitted to show that the reference is a publication of applicant's own invention.

COAUTHORSHIP

Where the applicant is one of the co - authors of a publication cited against his or her application, he or she may overcome the rejection by filing an affidavit or declaration under 37 CFR 1.131. Alternatively, the applicant may overcome the rejection by filing a specific affidavit or declaration under 37 CFR 1.132 establishing that the article is describing applicant's own work. An affidavit or declaration by applicant alone indicating that applicant is the sole inventor and that the others were merely working under his

Art Unit: 3661

direction is sufficient to remove the publication as a reference under 35 U.S.C. 102(a). In re Katz, 687 F.2d 450, 215 USPQ 14 (CCPA 1982).

DERIVATION

When the unclaimed subject matter of a patent or other publication is applicant's own invention, a rejection on that patent or publication may be removed by submission of evidence establishing the fact that the patentee or author derived his or her knowledge of the relevant subject matter from applicant. Moreover applicant must further show that he or she made the invention upon which the relevant disclosure in the patent or publication is based. In re Mathews , 408 F.2d 1393, 161 USPQ 276, 56 CCPA 1033 (CCPA 1969); In re Facius , 408 F.2d 1396, 161 USPQ 294, 56 CCPA 1384 (CCPA 1969).

That is NOT the case here. The patent is by John Ross.

MPEP § 716.10 *Attribution*

Under certain circumstances an affidavit or declaration may be submitted which attempts to attribute a reference or part of a reference to the applicant. If successful, the reference is no longer applicable. When subject matter, disclosed but not claimed in a patent application issued jointly to S and another, is claimed in a later application filed by S, the joint patent is a valid reference available as prior art under 35 U.S.C. 102(a), (e), or (f) unless overcome by affidavit or declaration under 37 CFR 1.131 showing prior invention (see MPEP § 715) or an unequivocal declaration by S under 37 CFR 1.132 that he or she conceived or invented the subject matter disclosed in the patent. Disclaimer by

Art Unit: 3661

the other patentee should not be required but, if submitted, may be accepted by the examiner.

Where there is a published article identifying the authorship (MPEP § 715.01(c)) or a patent identifying the inventorship (MPEP § 715.01(a)) that discloses subject matter being claimed in an application undergoing examination, the designation of authorship or inventorship does not raise a presumption of inventorship with respect to the subject matter disclosed in the article or with respect to the subject matter disclosed but not claimed in the patent so as to justify a rejection under subsection (f).

However, it is incumbent upon the inventors named in the application, in response to an inquiry regarding the appropriate inventorship under subsection (f) or to rebut a rejection under 35 U.S.C. 102(a) or (e), to provide a satisfactory showing by way of affidavit under 37 CFR 1.132 that the inventorship of the application is correct in that the reference discloses subject matter derived from the applicant rather than invented by the author or patentee notwithstanding the authorship of the article or the inventorship of the patent. In *re Katz*, 687 F.2d 450, 215 USPQ 14,18 (CCPA 1982) (inquiry is appropriate to clarify any ambiguity created by an article regarding inventorship and it is then incumbent upon the applicant to provide "a satisfactory showing that would lead to a reasonable conclusion that [applicant] is the ... inventor" of the subject matter disclosed in the article and claimed in the application).

An uncontradicted "unequivocal statement" from the applicant regarding the subject matter disclosed in an article or patent will be accepted as establishing

Art Unit: 3661

inventorship. In re DeBaun , 214 USPQ 933, 936 (CCPA 1982). However, a statement by the applicants regarding their inventorship in view of an article or a patent may not be sufficient where there is evidence to the contrary. Ex parte Kroger , 218 USPQ 370 (Bd. App. 1982) (a rejection under 35 U.S.C. 102(f) was affirmed notwithstanding declarations by the alleged actual inventors as to their inventorship in view of a nonapplicant author submitting a letter declaring the author's inventorship); In re Carriera , 189 USPQ 461 (CCPA 1976) (disclaiming declarations from patentees were directed at the generic invention and not at the claimed species, hence no need to consider derivation of the subject matter).

A successful 37 CFR 1.132 affidavit or declaration establishing derivation by the author or patentee of a first reference does not enable an applicant to step into the shoes of that author or patentee in regard to its date of publication so as to defeat a later second reference. In re Costello , 717 F.2d 1346, 219 USPQ 389, 392 (Fed. Cir. 1983).

That is not the case here.

Even with the EXAMPLES provided in the MPEP, the present situation is NOT applicable.

The following examples demonstrate the application of an attribution affidavit or declaration.

Example I

During the search the examiner finds a reference fully describing the claimed invention. The applicant is the author or patentee and it was published or patented less

Art Unit: 3661

than one year prior to the filing date of the application. The reference cannot be used against applicant since it does not satisfy the 1 - year time requirement of 35 U.S.C. 102(b).

Example 2

Same facts as above, but the author or patentee is an entity different from applicant. Since the entities are different, the reference is prior art under 35 U.S.C. 102(a) or (e).

In the situation described in Example 2, an affidavit under 37 CFR 1.132 may be submitted to show that the relevant portions of the reference originated with or were obtained from applicant. Thus the affidavit attempts to convert the fact situation from that described in Example 2 to the situation described in Example 1.

Furthermore, with regard to the affidavit under 37 CFR 1.131, 37 CFR 1.131 (b) states that " The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence satisfactorily explained" However, applicant fails to submit "original exhibits of drawings or record, or photocopies thereof", nor any "satisfactorilly explanation" of their absence is provided.

Art Unit: 3661

37 CFR 1.131(b) requires that original exhibits of drawings or records, or photocopies thereof, accompany and form part of the affidavit or declaration or their absence satisfactorily explained. In *Ex parte Donovan*, 1890 C.D. 109, 52 O.G. 309 (Comm'r Pat. 1890) the court stated: If the applicant made sketches he should so state, and produce and describe them; if the sketches were made and lost, and their contents remembered, they should be reproduced and furnished in place of the originals. The same course should be pursued if the disclosure was by means of models. If neither sketches nor models are relied upon, but it is claimed that verbal disclosures, sufficiently clear to indicate definite conception of the invention, were made the witness should state as nearly as possible the language used in imparting knowledge of the invention to others.

The evidence submitted by appellant did not meet those requirements of 37 CFR 1.131

Given the facts presented in the prosecution of the present applicant it cannot be determined whether the claimed subject matter was conceived before the effective filing date of the Ross patents.

The patents to Ross disclose the computer associated with the user and a base station computer establishes a connection between the user and communicates the travel data. See Ross '770 at columns 3-5 and Ross '444 at columns 3-6.

For the above reasons, it is believed that the rejections should be sustained and affirmed by the Board.

Art Unit: 3661

Respectfully submitted,

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October 28, 1999

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